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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,534	07/13/2001	Hiroshi Sakurai	1081.1125	2164
21171	7590	10/20/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,534	Applicant(s) SAKURAI, HIROSHI	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-23 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on August 2, 2006, cancelled no claims. Claims 1, 4, 9, 12-14, and 17 have been amended and Claims 22 and 23 have been added. Thus the currently pending claims are Claims 1-23.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9 and 17 indicate that the level of contribution corresponds to "importance, credibility, novelty". There is no indication as to whether the applicant means "importance, credibility, and novelty" or "importance, credibility, or novelty". Therefore, the examiner has interpreted the applicants intention to be the "importance, credibility, or novelty" when rejecting the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claims 1, 22, and 23. Goldhaber discloses a method for distributing advertisements to a user through a computer network, comprising the steps of:

- a. Storing advertiser registration information including advertisement information for goods and/or services provided by an advertiser according to a registration request by said advertiser (Col 14, lines 17-40; and Col 15, lines 17-30)
- b. Storing user registration information including search conditions for goods and/or services specified by said user according to a registration request by said user (Col 12, line 59 through Col 13, line 47)
- c. Extracting advertisement information matching said search conditions from among said stored advertisement information. (Col 14, lines 59-67)
- d. Distributing said extracted advertisement information to said user. (Col 14, lines 59-67)
- e. Judging a level of contribution, of a questionnaire response, to said advertiser and determining a reward amount for each questionnaire response on the basis of the level of contribution. (Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (The reward in the prior art is one of two amounts that can

be determined. The person can either earn the entire reward amount or no reward amount.)

Claim 2. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein said computer network is the Internet; and said extracted advertisement information is distributed as an Internet home page screen to a terminal of said user connected to the Internet. (Col 7, lines 28-47; and Col 9, lines 33-67)

Claim 3. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein said computer network is the Internet; and said extracted advertisement information is distributed as electronic mail to the terminal of said user connected to the Internet. (Col 6, lines 3-22; and Col 9, lines 33-67)

Claim 4. Goldhaber discloses the method for distributing advertisements according to claim 1, comprising:

- a. Storing questionnaires relating to goods and/or services corresponding to said distributed advertisement information and relating to advertisers providing these goods and/or services. (Col 16, lines 6-17)
- b. Distributing said questionnaires to said users (Col 16, lines 6-17)
- c. Receiving and storing responses to said questionnaires from said users. (Fig 12, and Col 16, lines 6-17)

Claim 5. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein said questionnaires include pre-purchase questionnaires for said user to respond before said user purchases the goods and/or services corresponding to said distributed advertisement information, or post-purchase questionnaires for said user to respond after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 6. Goldhaber discloses the method for distributing advertisements according to claim 5, wherein said pre-purchase questionnaires include questions for gathering impressions said user has of said goods and/or services, or of the advertisers providing these goods and/or services, before said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 7. Goldhaber discloses the method for distributing advertisements according to claim 5, wherein said post-purchase questionnaires include questions for gathering feelings and opinions said user has of said goods and/or services, or of the advertisers providing these goods and/or services, after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 8. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein a prescribed reward amount is paid to users who respond to said questionnaires. (Col 16, lines 6-17)

Claim 9. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein the level of contribution is calculated by using parameters corresponding to importance, credibility, or novelty of the questionnaire response. (Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber verifies the credibility of the response by checking to see if its completed and whether the account is "bad" or not.)

Claim 10. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein results of compiling said questionnaire responses for a specific advertiser or the goods and services provided by the advertiser are distributed to said specific advertiser. (Fig 12; and Col 17, lines 33-63)

Claim 11. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein advertisement information matching said search conditions is extracted on the basis of said questionnaire responses. (Col 17, line 64 – Col 18, line 33)

Claim 12. Goldhaber discloses the method for distributing advertisements according to claim 1, comprising:

- a. Receiving questions, regarding goods and/or services corresponding to said distributed advertisement information or regarding the specific advertiser providing these goods and/or services, from a specific user. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)
- b. Storing said questions and then forwarding the questions to said specific advertiser. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)
- c. Receiving a response to said questions from said specific advertiser. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)

- d. Storing the response to said questions and then distributing the response to the questions to said specific user. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)

Claim 13. Goldhaber discloses the method for distributing advertisements according to claim 12, comprising:

- a. Setting a response deadline for the response to said questions for said specific advertiser. (Col 4, lines 47-62) (An auction inherently includes a deadline for auction completion thereby urging bidders to respond.)
- b. Urging said specific advertiser to respond to said questions when a response to said questions is not received by said response deadline. (Col 4, lines 47-62) (An auction inherently includes a deadline for auction completion thereby urging bidders to respond.)

Claim 14. Goldhaber discloses an apparatus for distributing advertisements to users through a computer network, comprising:

- a. A memory unit for storing advertiser registration information, including advertisement information for goods and/or services provided by an advertiser, according to a registration request by the advertiser; and storing user registration information including search conditions for goods and/or services specified by said user according to a registration request by said

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- user. (Col 12, line 59 through Col 13, line 47; Col 14, lines 17-40; and Col 15, lines 17-30)
- b. A control unit for extracting advertisement information, matching said search conditions, from among said stored advertisement information; and distributing said extracted advertisement information to said user. (Col 14, lines 59-67)
- c. Wherein said control unit judges a level of contribution, of a questionnaire response, to said advertiser, and determines a reward amount for each questionnaire response on the basis of the level of contribution, in the case where a prescribed reward amount is paid to users who respond to questionnaires. (Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber indicates that user interaction with the advertisement may be required. When this is necessary the prior art discloses that appropriate answers to questions or information requested needs to be provided. Therefore, as each question is checked, a reward amount is determined, the user is either still eligible for the full reward amount or no reward amount)

Claim 15. Goldhaber discloses the apparatus for distributing advertisements according to claim 14, wherein said memory unit stores questionnaires relating to goods and/or services corresponding to said distributed advertisement information and relating to advertisers providing these goods and/or services; and said control unit distributes said questionnaires to said users, receives responses to said

questionnaires from said users, and stores responses to the questionnaires in said memory unit. (Fig 12, and Col 16, lines 6-17)

Claim 16. Goldhaber discloses the apparatus for distributing advertisements according to claim 15, wherein said questionnaires include pre-purchase questionnaires for said user to respond before said user purchases the goods and/or services corresponding to said distributed advertisement information, or post-purchase questionnaires for said user to respond after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17)

Claim 17. Goldhaber discloses The apparatus for distributing advertisements according to claim 14, wherein the level of contribution is calculated by using parameters corresponding to importance, credibility, or novelty of the questionnaire response. (Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3)
(Goldhaber verifies the credibility of the response by checking to see if its completed and whether the account is "bad" or not.)

Claim 18. Goldhaber discloses The apparatus for distributing advertisements according to claim 15, wherein said control unit compiles said questionnaire responses for a specific advertiser or the goods and/or services provided by the advertiser and distributes the compiled results to said specific advertiser. (Fig 12;

and Col 17, lines 33-63)

Claim 19. Goldhaber discloses The apparatus for distributing advertisements according to claim 15, wherein said control unit extracts advertisement information, matching said search conditions on the basis of said questionnaire responses. (Col 17, line 64 through Col 18, line 33)

Claim 20. Goldhaber discloses The apparatus for distributing advertisements according to claim 14, wherein, upon receiving questions, from a specific user, regarding goods and/or services corresponding to said distributed advertisement information or regarding the specific advertiser providing these goods and/or services, said control unit stores said questions in said memory unit and then forwards the questions to said specific advertiser; and upon receiving the response to said questions from said specific advertiser, said control unit stores the response to said questions in said memory unit and then distributes the response to the questions to said specific user. (Col 15, lines 1-6; and Col 17, line 64 through Col 18, line 59)

Claim 21. Goldhaber discloses The apparatus for distributing advertisements according to claim 20, wherein said control unit sets a response deadline for the response to said questions for said specific advertiser, and urges said specific

advertiser to respond to said questions when a response to said questions is not received by said response deadline. (Col 4, lines 47-62)

Response to Arguments

6. Applicant's arguments filed August 2, 2006 have been fully considered but they are not persuasive. The argument directed towards the applicants amendments are addressed in the 35 U.S.C. 112 and 35 U.S.C. 102 sections above.
 - a. The applicant argues that Goldhaber does not teach the limitations of Claim 7 because the applicants claims are limited to "feelings and opinions a user has for goods and/or services" that are ascertained after the user purchases the goods or services. Aside from the fact that Claim 7, holds little or no patentable weight because Claim 6, by reciting "or" does not positively state that a post purchase questionnaire will ever be provided, Goldhaber does teach such an interaction. Goldhaber discloses that is keeps track of user interactions and transactions for use in targeting advertisements, including purchases (Col 6, lines 24-60). This information is disclosed as being used for targeting questionnaires and thus the gathering of information regarding the "feelings and opinions of a user that has previously purchased the goods and/or services" is disclosed.
 - b. The applicant's arguments regarding Claims 12, 13, 20, and 21 seem to indicate limitations, which are not provided in the claims themselves. The questions received by the advertisers are not required to be written by the

user. As currently written the claims read over a customer completing a survey and sending it back to the advertiser. In this instance the advertiser writes the questions; sends them to the user; and then the questions, along with the answers are returned to the advertiser. The user then receives a response (reward amount) from the advertiser that is stored in the users account. The examiner's interpretation of "receiving questions" is supported by the applicants claims since Claim 14 indicates that responses to questionnaires are being received and dependent claims 20 recites "upon receiving questions".

- c. The applicant's argument in reference to the limitations of Claim 16 requiring the prior art explicitly disclose the use of "post-purchase questionnaires" is baseless. The claims recites "pre-purchase questionnaires" "and/or" "post-purchase questionnaires". Therefore, a recitation of "post-purchase questionnaires" in the prior art is not required.

Conclusion

- 7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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